

**Amendment and Response**

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Serial No. 09/997,931

Filing Date: November 30, 2001

Title: CIRCULAR DNA VECTORS FOR SYNTHESIS OF RNA AND DNA

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**Remarks**

The Office Action mailed July 28, 2004 has been received and reviewed. Claims 96-100, 113, 115, 117, and 121 having been amended, and claims 95, 116, 118, 119, 122 and 123 having been canceled, without prejudice, the pending claims are claims 96-115, 117, 120 and 121.

Claims 96-98, 100, 113, 115, 117 and 121 have been rewritten in independent form. Claim 99 has been amended to depend from claim 97.

Reconsideration and withdrawal of the rejections, in view of the above amendments and the following comments, are respectfully requested.

**Restriction Requirement**

Applicant acknowledges with appreciation the Examiner's modification of the restriction requirement in accordance with Applicant's Supplemental Response mailed May 5, 2004, and also the withdrawal of the species requirement.

Applicant also notes the Examiner's withdrawal of claims 119 and 122 from Group I insofar as they are directed to a method of nucleic acid based treatment in an animal (Group II). It is understood however that the elected claims (Group I) which are directed to methods of synthesizing an RNA oligonucleotide in a cell encompass, for example, non-treatment methods such as diagnostic methods in an animal. If Applicant is incorrect in this assumption, clarification is respectfully requested.

**Objections to Claims**

Claims 96-115, 117, 120 and 121 were objected to as being dependent upon a rejected base claim (i.e., claim 95) but would be allowable if rewritten in dependent form including all of the limitations of the base claim and any intervening claims and limited to the elected invention (i.e., a method of synthesizing an RNA oligonucleotide in a cell).

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Claims 96, 97, 98, 100, 113, 115, 117 and 121 have been rewritten as independent claims, thereby obviating the objection. Reconsideration and withdrawal of the objection to claims 96-115, 117, 120 and 121 is respectfully requested.

**The 35 U.S.C. §112, First Paragraph, Rejection**

The Examiner rejected claim 95 under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner alleges that the specification provides insufficient written description to support the genus encompassed by the claim. In particular, the Examiner asserts that the specification does not provide any structure that would define, as a class, molecules that may treat any particular disease.

This rejection is respectfully traversed. It is respectfully submitted that the description in the specification of methods of nucleic acid based treatment is sufficient to satisfy the written description requirement under 37 C.F.R. 112, first paragraph. Further, various nucleic acid compounds useful for treatment of disease are well known to the skilled artisan.

However, solely in the interest of furthering prosecution of the present application, Applicant has cancelled claim 95, thereby rendering the Examiner's rejection moot.

Reconsideration and withdrawal of the rejection of claim 95 are, therefore, respectfully requested.

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**Summary**

It is respectfully submitted that the pending claims 96-115, 117, 120 and 121 are in condition for allowance and notification to that effect is respectfully requested.

The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for

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By

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**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 7th day of December, 2004, at 12:28pm (Central Time).

By:

Name:

Sara E. Olson  
**Sara E. Olson**